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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,366	12/01/2003	Iwao Saikatsu	032126	8101

38834 7590 06/22/2006

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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/724,366

Applicant(s)

SAIKATSU ET AL.

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The outstanding claim objection is withdrawn in light of applicant's amendment filed 4/25/2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
3. No new ground of rejection are set forth below. Thus, the following action is properly made final.

### ***Claim Rejections - 35 USC § 103***

4. Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brewer (US 5,856,278) in view of Hiles (US 4,049,396).

The rejection is adequately set forth in paragraph 5 of Office action mailed 1/27/2006 and is incorporated here by reference.

### ***Response to Arguments***

5. Applicant's arguments filed 4/25/2006 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that Brewer does not properly teach 1-10 vol % abrasive particles because the 5-80 vol % recitation is a typographical error and was clearly intended to be 15-80 vol %; (B) that the solvated NBR of Brewer is crosslinked, i.e., vulcanized; and (C) that aluminum oxide and silicon carbon are not equivalent and interchangeable as abrasive fillers because they have different hardnesses.

With respect to argument (A), Brewer explicitly discloses an amount of 5-80 vol % of abrasive particles (col. 1, line 39). The examiner has looked to what the reference teaches. While Brewer only exemplifies amounts of abrasive particles of 15, 20, and 40 vol % and claims an amount of 15-80 vol %, such does not immediately preclude the endpoint 5 vol % from being disclosed. Case law holds that it is perfectly proper for the examiner to look to the whole reference for what it teaches rather than merely rely on preferred embodiments. *In re Courtright* 153 USPQ 735 (CCPA 1967). Furthermore, applicant has only shown that the endpoint 5 vol % is possibly a typographical and not necessarily one.

With respect to argument (B), it is well recognized that vulcanizing rubber is a type of crosslinking. Evidence to support the examiner's position is found in *Hawley's Condensed Chemical Dictionary* which teaches that vulcanization is crosslinking with sulfur. Hence, even though the solvated NBR of Brewer is crosslinkined it is not vulcanized and is therefore unvulcanized rubber.

With respect to argument (C), Hiles teaches a variety of abrasive particles, including aluminum oxide and silicon carbide, which are suitable as abrasive particles in friction materials. While the hardness of the different abrasive particles are different (as would be expected since they are different materials with different chemical compositions), that does not preclude them being suitable for the same utility which is taught by Hiles. It was not the examiner's position that silicon carbide and alumina are the same but that silicon carbide and alumina are equivalent and interchangeable when used in friction materials even if one is harder than the other.

*Conclusion*

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

6/21/2006

Vickey Ronesi



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